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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/554,912	08/18/2000	Par Holmberg	9847-0058-6X	6636
22850	7590	12/05/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			DOERRLER, WILLIAM CHARLES	
			ART UNIT	PAPER NUMBER
			3744	

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/554,912	<b>Applicant(s)</b> HOLMBERG ET AL.	
	<b>Examiner</b> William C. Doerrler	<b>Art Unit</b> 3744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7-30-03, in light of the 11-8-05 decision
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37-79 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37-61 and 79 is/are allowed.
- 6) ☒ Claim(s) 62-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 62 and 68-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prueitt in view of Elton et al.

Prueitt discloses applicants' basic inventive concept, an energy storage system using a coiled superconductor with a switch (see figure 4), substantially as claimed with the

exception of protecting the superconductor with two semi-conducting layers separated by an insulation layer and means to keep the outer semi-conducting layer at a ground potential. Elton shows this feature to be old in the conductor with field protection art. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention from the teaching of Elton to modify the superconducting energy storage system of Prueitt by protecting the superconductor with a layer of semiconductor material which is surrounded by a layer of insulation which is in turn surrounded by an outer semiconductor layer which is kept at ground potential to avoid corona discharge to provide an efficient and safe superconductor wire. Prueitt talks of the need to cool the contents of box 10 to cryogenic temperatures. One of ordinary skill in the art would consider it obvious to insulate box 10 to preserve cryogen. Such insulation would surround the superconductor, since the box surrounds the superconductor.

Claims 75-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prueitt in view of Elton et al as applied to claims 62 and 68-74 above, and further in view of the '195 UK reference from the International Search report.

Prueitt, as modified, discloses applicants' basic inventive concept, an energy storage device using a superconductor with multiple layers of insulation, substantially as claimed with the exception of a fluid passage through the center of the superconductor and using ethylene propylene (propylene) rubber as the insulation layer. The '195 UK reference shows these features to be old in the superconductor art. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention from the teaching of the '195 UK reference to modify the superconducting device of Prueitt by

providing a cryogen through the middle of the superconductor to ensure a proper temperature and to use EPR as the insulation to ensure effective insulation.

Claims 63-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prueitt in view of Elton et al as applied to claims 62 and 68-74 above, and further in view of Donaldson.

Prueitt, as modified, discloses applicants' basic inventive concept, an energy storage device using a superconductor with multiple layers of insulation, substantially as claimed with the exception of specifying that the device can be used for high voltage applications. Donaldson shows this feature to be old in the superconductor art in column 4 line 29. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention from the teaching of Donaldson to modify the superconducting device of Prueitt by using such a device in a high voltage transfer situation to ensure constant output voltage. Official Notice is taken that AC/DC converters are well known in the high voltage transfer art and as such would have been an obvious modification for an ordinary practitioner in the art.

#### ***Allowable Subject Matter***

Claims 37-61 and 79 are allowed.

#### ***Response to Arguments***

Applicant's arguments filed 7-30-2003 have been fully considered but they are not persuasive. Applicants state that the proposed combination would produce a brittle cable which could not be wound into a coil. None of the rejected claims claim that the

cable is wound into a coil. It is unclear why the proposed combination cannot be formed as a coil (i.e. with each layer formed and cured in turn). It is noted that Elton et al also states in the background of the invention that such cables are used as windings. Prueitt states in line 29 of column 4 that 200 kwh can be produced by the device. This is seen to teach applicant's claimed range.

### ***Conclusion***


**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Doerrler whose telephone number is (571) 272-4807. The examiner can normally be reached on Monday-Friday 6:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl Tyler can be reached on (571) 272-4834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William C Doerrler  
Primary Examiner  
Art Unit 3744

WCD